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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,790	09/27/2005	Yuichi Marikawa	5341-57PUS	1803
27799 7590 03/24/2011 COHEN, PONTANI, LIEBERMAN & PAVANE LLP 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176				
EXAMINER				
HAQ, NAEEM U				
ART UNIT		PAPER NUMBER		
3625				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/550,790

Applicant(s)

MARIKAWA ET AL.

Examiner

NAEEM HAQ

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7, and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 4-6, 8-10 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-040)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

Claims 4-6, 8-10, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokomizo et al. (US 2002/0067500 A1) (“Yokomizo”) in view of Knight (US 6,344,853 B1).

Referring to claims 1, 7, and 11: Yokomizo teaches an image-editing service system comprising: a network (paragraph [0002]); a server connecting to the network (paragraph [0034]); a user terminal for performing a design order connecting to the network (paragraph [0043]); an administrator terminal connecting to the network for receiving the design order via the server and performing an order of image-editing work based on the design order (paragraph [0212]); a worker terminal connecting to the network for performing image-editing based on the order of image-editing work and for creating an image information (paragraphs [0169] and [0170]); and, the server comprising; a database for storing the image information sent from worker terminal

(paragraph [0168]); a first image generating section for generating a first image based on the image information stored in the database (paragraph [0197]); a display section for displaying an image display frame so as to display the first image in a display window of the user terminal and displaying a window information so as to display a display condition of the first image which is allowed to be input (Figure 7, "70").

Yokomizo does not teach a second image generating section for generating a second image regard to the first image based on the display condition inputted by the user terminal; and, a window information generating section for displaying the first image and the second image simultaneously. However, Knight teaches a method and apparatus that generates a second image regard to the first image based on the display condition inputted by the user terminal; and, a window information generating section for displaying the first image and the second image simultaneously (Figure 3D; Abstract, lines 1-3; col. 1, lines 7-22; col. 3, lines 1-7; col. 4, lines 12-27). It would have been obvious to one of ordinary skill in the art to include in the invention of Yokomizo the composite imaging ability of Knight since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokomizo et al. (US 2002/0067500 A1) ("Yokomizo") in view of Knight (US 6,344,853 B1) and further in view of Hama et al. (US 4,751,507) ("Hama").

The cited prior art does not teach a display section for displaying the first image can select either a whole display or a partial display on the display window of the user terminal; wherein the window information generating section for displaying the first image and the second image simultaneously when the whole display is selected by the user terminal, while displaying a portion of the first image when the partial display is selected by the user terminal. However, Hama teaches a partial display of an image (Figure 5, "23" and "25"). It would have been obvious to one of ordinary skill in the art to include in the invention of Yokomizo the partial display ability if Hama since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

Applicants' arguments filed have been fully considered but they are not persuasive. The Applicants have argued that the examiner failed to provide a prima facie case of obviousness because the examiner did not provide any reasoning for the combination. The examiner respectfully disagrees. Yokomizo is directed to a system and method for editing images. For example, Yokomizo teaches red-eye processing of an image (Figure 4, "41"; Figure 5, "32-1") as well as oil-paint and sepia processing ([0102]). On the other hand, Knight is directed to an apparatus and method for editing images by superimposing one image on another image (Figure 3D; Abstract, lines 1-3;

col. 1, lines 7-22; col. 3, lines 1-7; col. 4, lines 12-27). The combination of Yokomizo and Knight would have been obvious to one of ordinary skill in the art because the result of the combination (i.e. adding an additional image editing feature to the invention of Yokomizo) is predictable. Yokomizo provides image editing features and simply adding another image editing feature to Yokomizo does not create any unpredictable and nonobvious results. Moreover Yokomizo states, "*The user can effect additional edition on the partly-edited document file, i.e., the template, so as to complete a target image in accordance with his taste.*" ([0032]) The addition of Knight's image editing feature into Yokomizo's image editing invention would enhance a user's ability to further create an image "in accordance with his taste."

For this reason, the examiner maintains the art rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAEEM HAQ whose telephone number is (571)272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Naeem Haq/
Primary Examiner, Art Unit 3625

March 21, 2011